

REMARKS

Claims 1, 2 and 4 to 7 are in this application. Claims 3 and 8-12 have been cancelled. Applicants preserve all rights to file one or more divisional applications directed to the subject matter of claims 8-12.

Claim 1 has been amended to define a process for the preparation of 1-Propyl-2,4,5-trimethoxybenzene of the formula I from crude calamus oil from a tetraploid or hexaploid *Acorus calamus* wherein said crude calamus oil contains alpha, beta and gamma asarone Support for this amendment is found on page 8, line 19; page 15, lines 8-9 and 18-19, page 19, paragraph 9 of the specification.

According to the Office Action it is stated that "claims 1-7 are rejected under 35 USC 103(a) as being obvious over Devgan alone or in view of Patra et al and further in view of March". Applicants respectfully traverse this.

Claim 1 has been amended to define a process for the preparation of 1-Propyl-2,4,5-trimethoxybenzene of the formula I from crude calamus oil from a tetraploid or hexaploid *Acorus calamus* wherein said crude calamus oil contains alpha, beta and gamma asarone.

Devgan discloses a process for isolating γ -asarone from *Caesulia axillaries*. There is no suggestion or disclosure in Devgan that the process claimed in this application can be used to prepare 1-Propyl-2,4,5-trimethoxybenzene of the formula I from crude calamus oil wherein said crude calamus oil contains alpha, beta and gamma asarone.

The standard test used to establish *prima facie* obviousness is the test set out by the Supreme Court in *Graham v. John Deere* (383 US 1, 148 USPQ 459 (1966)). To determine whether a claim is *prima facie* obvious:

- 1) the scope and content of the prior art are to be determined;
- 2) the differences between the prior art and the claims at issue are to be ascertained; and
- 3) the level of ordinary skill in the pertinent art resolved.

In addition, according to MPEP 2141, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n. 5 (Fed. Cir. 1986), when applying 35 USC 103, the following tenets of patent law must

be adhered to:

- 1) the claimed invention must be considered as a whole;
- 2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; and
- 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Therefore, considering the claimed invention and references as a whole, there is no suggestion in the references to prepare 1-Propyl-2,4,5-trimethoxybenzene of the formula I from crude calamus oil from a tetraploid or hexaploid *Acorus calamus* wherein said crude calamus oil contains alpha, beta and gamma asarone. One skilled in the art knows that a reaction using a single compound as a starting material differs from a reaction when an oil from a plant is used. The oil of a plant contains a number of components which may result in different products produced than when a single compound is used as the starting material. There may be side reactions, some components not reacting under the stated conditions, etc. Therefore, one skilled in the art seeking to produce 1-Propyl-2,4,5-trimethoxybenzene of the formula I from crude calamus oil would not from Devgan have a reasonable expectation of success.

One skilled in the art considering Patra alone or in combination with Devgan would not have a reasonable expectation that 1-Propyl-2,4,5-trimethoxybenzene of the formula I could be produced from crude calamus oil in the manner in which applicants' have achieved this result. There is no suggestion in Patra that 1-Propyl-2,4,5-trimethoxybenzene can be produced from crude calamus oil. March in combination with these references does not overcome the deficiencies of Devgan and Patra.

Therefore, it is respectfully requested that the rejection be withdrawn.

Applicants submit that the present application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted,



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